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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,823	05/29/2001	Lalitha Agnihotri	US 010228	5093

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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BRIARCLIFF MANOR, NY 10510

EXAMINER
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SHEPARD, JUSTIN E

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/866,823

Applicant(s)

AGNIHOTRI ET AL.

Examiner

Justin E. Shepard

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 5/17/06 have been fully considered but they are not persuasive.

Page 10, last paragraph (referring to claim 17):

The applicant argues that there is no description of a server having memory. The passage cited (paragraph 16, line 6-9) refers to the VRD, which is defined in the application to be a Video Recording Device. From the application (paragraph 29) "a VRD is characterized as having the inherent capability to connect to the Internet and communicate with a server. Also it is stated, "that its means of storage is that of a common computer hard disk rather than common video tape." These statements show that the VRD acts as a server containing recorded shows for users to access. The fact that it tracks the "Minutes of Storage Available" (paragraph 35) shows that the device is able to keep track of its internal storage and provide the amount of available storage using the amount of recording time left as a unit of measure. The rejection stands.

Page 11, 3<sup>rd</sup> paragraph from bottom of page (referring to claim 1):

The applicant argues that figure 2 does not reveal a second controller. Figure 2 shows a timeline of what occurs when one of the two controllers runs out of space while recording a program. The two controllers are shown in figure 1 (parts 3 and 4) as cited in the Office Action (page 3, 5 lines from the bottom of the page). Figure 2 discloses VCR1 executing recording (far left column, 2<sup>nd</sup> section of words from the top), and that it

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also monitors available capacity (far left column, next section down). If the available capacity is low (far left column, next section down), the controller sends a request (over the IEE1394 network) to VCR2 to see if it has available capacity (2<sup>nd</sup> column from left, 3 sections down). If there is capacity, VCR executes the recording (far right column).

The examiner has provided a thorough and complete examination, and the previous rejection stands.

What follows are the original rejections from the previous Office Action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Susskind.

Referring to claim 17, Susskind discloses a server for use in a communication network coupled to a plurality of video playback devices (figure 1, parts 11 and 12), a server comprising a memory for storing plurality of data files related said plurality of video playback devices (paragraph 16, lines 6-9), wherein each of said plurality of data

files comprises disk status indicator indicating an amount free space available on a disk drive in a selected one of said video playback devices (paragraph 35, lines 16-17).

Referring to claim 18, Susskind discloses a server as set forth in Claim 17 wherein each of said plurality of data files further comprises a recording schedule table indicating a list of television programs scheduled to be recorded by said selected one of said video playback devices (paragraph 12, lines 2-9).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Utsunomiya.

Referring to claim 1, Utsunomiya discloses a video playback device comprising: a disk storage device capable of storing (figure 1, parts 3 and 4; paragraph 43, lines 6-8) television programs received from an external source (paragraph 40, lines 1-3); a first controller capable of receiving a first program recording command, wherein said first program recording command is operable to cause said first controller to store a first television program on said disk storage device during a first time slot (figure 2); and a

second controller capable of determining if sufficient space is available on said disk storage device to store said first television program (figure 2), wherein said disk storage device, in response to a determination that sufficient space is not available on said disk storage device is further capable of identifying in an external communication network (paragraph 39, lines 6-7; figure 2) a second remote video playback device capable of recording said first television program and transmitting a recording task request to said second remote video playback device (figure 2), wherein said recording task request is operable to cause said second remote video playback device to record said first television program during said first time slot (paragraph 50, lines 3-7).

Claim 9 is rejected on the same grounds as claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsunomiya in view of Potrebic.

Referring to claim 2, Utsunomiya in view of Hanai discloses a device wherein a first storage device transfers the program recording to a second storage device.

Utsunomiya does not disclose a video playback device as set forth in Claim 1 wherein said second controller is further capable of comparing said first program

recording command to a second program recording command previously received by said first controller and determining if a second time slot associated with said second program recording command overlaps said first time slot.

Potrebic discloses a video playback device as set forth in Claim 1 wherein said second controller is further capable of comparing said first program recording command to a second program recording command previously received by said first controller and determining if a second time slot associated with said second program recording command overlaps said first time slot (figure 4; column 9, lines 20-26 and 32-34).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the method to determine whether 2 requested programs overlapped, as taught by Potrebic, to the device disclosed by Utsunomiya. The motivation would have been that the system disclosed by Potrebic allows the recording of multiple programs with a single STB by using multiple tuners, while the system disclosed by Utsunomiya contains multiple tuners not contained within the same STB and would therefore allow the recording of overlapping programs.

Claim 10 is rejected on the same grounds as claim 2.

Referring to claim 3, Utsunomiya discloses a video playback device as set forth in Claim 2 wherein said second controller, further capable of accessing said second remote video playback device via said external communication network and transmitting said recording task request to said second remote video playback device, wherein said recording task request is operable cause said second remote video playback device record said first television program during said first time slot.

Utsunomiya does not disclose performing the above action in response to a determination that said first and second time slots overlap.

Potrebic discloses performing the above action in response to a determination that said first and second time slots overlap.

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the method to determine whether 2 requested programs overlapped, as taught by Potrebic, to the device disclosed by Utsunomiya. The motivation would have been that the system disclosed by Potrebic allows the recording of multiple programs with a single STB by using multiple tuners, while the system disclosed by Utsunomiya contained multiple tuners not contained within the same STB and would therefore allow the recording of overlapping programs.

Claim 11 is rejected on the same grounds as claim 3.

Claims 4-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsunomiya in view of Potrebic as applied to claims 1, 2, 9, and 10 above, and further in view of Susskind.

Referring to claim 4, Utsunomiya et al. does not disclose a video playback device as set forth in Claim 3 further comprising a memory for storing said first and second program recording commands in a recording schedule table.

Susskind discloses a video playback device as set forth in Claim 3 further comprising a memory for storing said first and second program recording commands in a recording schedule table (paragraph 12, lines 2-9).



At the time of the invention it would have been obvious for one of ordinary skill in the art to add the central database to hold individual recorder information taught by Susskind to the previously disclosed device. The motivation would have been to enhance the usability and usefulness of the video playback device.

Claim 12 is rejected on the same grounds as claim 4.

Referring to claim 5, Utsunomiya et al. does not disclose a video playback device as set forth in Claim 3 wherein said second controller identifies said second remote video playback device by accessing a central server in said external communication network and requesting from said central server a list of remote video playback devices capable of recording said first television program.

Susskind discloses a video playback device as set forth in Claim 3 wherein said second controller identifies said second remote video playback device by accessing a central server in said external communication network and requesting from said central server a list of remote video playback devices capable of recording said first television program (paragraph 12, lines 2-9; paragraph 16, lines 6-9).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the web server to identify a storage device, as taught by Susskind, in the device previously disclosed. The motivation would have been to enhance the usability and usefulness of the video playback device.

Claim 13 is rejected on the same grounds as claim 5.

Referring to claim 6, Utsunomiya does not disclose a video playback device as set forth in Claim 5 wherein said second controller is capable of transmitting to said

central server disk space status information regarding an amount of available space on said disk storage device.

Susskind discloses a video playback device as set forth in Claim 5 wherein said second controller is capable of transmitting to said central server disk space status information regarding an amount of available space on said disk storage device (paragraph 35, lines 16-17; paragraph 16, lines 6-9).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the web server to identify a storage device, as taught by Susskind, in the device previously disclosed. The motivation would have been to enable the connection of the recorders to be connected by CAT5 (or some other networking cable), and not IEEE1394, which would be expensive to run long distances, so that the recorders could be placed in separate rooms.

Claim 14 is rejected on the same grounds as claim 6.

Referring to claim 7, Utsunomiya et al. does not disclose a video playback device as set forth in Claim 6 wherein said second controller is further capable of transmitting to said central server a program recording schedule regarding television programs scheduled to be recorded by said video playback device.

Susskind discloses a video playback device as set forth in Claim 6 wherein said second controller is further capable of transmitting to said central server a program recording schedule regarding television programs scheduled to be recorded by said video playback device (paragraph 12, lines 2-9; paragraph 16, lines 6-9).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the central database to hold individual recorder information taught by Susskind to the previously disclosed device. The motivation would have been to enhance the usability and usefulness of the video playback device.

Claim 15 is rejected on the same grounds as claim 7.

Referring to claim 8, Utsunomiya does not disclose a video playback device as set forth in Claim 7 wherein said second controller is further capable of receiving from a third video playback device an incoming recording task request, wherein said incoming recording task request is operable to cause said video playback device to record a requested television program associated with said incoming recording task request.

Susskind discloses a video playback device as set forth in Claim 7 wherein said second controller is further capable of receiving from a third video playback device an incoming recording task request, wherein said incoming recording task request is operable to cause said video playback device to record a requested television program associated with said incoming recording task request (figure 1, part 10).

At the time of the invention it would have been obvious for one of ordinary skill in the art to scale the system disclosed by Utsunomiya to more than 2 recorders as taught by Susskind. The motivation would be that the more recorders that were part of the system, the more total recording capacity the users would have in being able to records shows.

Claim 16 is rejected on the same grounds as claim 8.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Susskind in view of Utsunomiya.

Referring to claim 19, Susskind does not disclose a server as set forth in claim 18, wherein said server is capable of receiving from a first one of said video playback devices a recording task request associated with a first television program, wherein said server, response receipt of said recording task request determines second one said video playback devices capable of recording said first television program.

Utsunomiya discloses a server as set forth in claim 18, wherein said server is capable of receiving from a first one of said video playback devices a recording task request associated with a first television program, wherein said server, response receipt of said recording task request determines second one said video playback devices capable of recording said first television program (figure 2).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the recording programs on other recorders method taught by Utsunomiya to the server disclosed by Susskind. The motivation would have been to enable a program to be recorded in full even if the original recorder runs out of space (Utsunomiya: paragraph 3, lines 3-8).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Susskind in view of Utsunomiya as applied to claim 19 above, and further in view of Mitchell.

Referring to claim 20, Susskind in view of Utsunomiya does disclose a server as set forth in Claim 19 wherein said server transmits to said first video playback device a network address associated with said second video playback device.

Mitch discloses a server as set forth in Claim 19 wherein said server transmits to said first video playback device a network address associated with said second video playback device (Abstract: lines 3-5).

At the time of the invention it would have been obvious for one of ordinary skill to transmit the address of the recorder, as taught by Mitchell, in the system previously disclosed. The motivation would have been to enable the original recorder to obtain the recorded program after the recording has finished (Mitchell: Abstract: lines 6-9).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS



**CHRISTOPHER GRANT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600**